

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Walter WOLF
Title: CROSS MEMBER HAVING A HYBRID STRUCTURE
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Examiner: Helena KOSANOVIC
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PRE-APPEAL BRIEF REQUEST FOR REVIEW

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Sir:

In accordance with the New **Pre-Appeal Brief Conference Pilot Program**, announced July 11, 2005, this Pre-Appeal Brief Request is being filed together with a Notice of Appeal in response to the Advisory Action dated June 21, 2007, and the Final Office Action dated February 15, 2007.

REMARKS

The PTO has rejected claims 14-18 and 21-28 under 35 U.S.C. 102(b) as being anticipated by EP 0662901 ("Pasch"), and claims 19-20 under 35 U.S.C. 103(a) as being unpatentable over Pasch in view of JP 11-319552 ("Mochizuki"). These rejections should be withdrawn because neither Pasch, Mochizuki, nor any combination thereof identically discloses or describes, or teaches each and every element of claim 14.

Anticipation Rejection of Claims 14-18 and 21-28 based on Pasch

As to the rejection of claims 14-18 and 21-28 under 35 U.S.C. 102(b), Pasch does not “identically disclose or describe” (See § 103) the claimed invention, either explicitly or inherently, as required by § 102.

For example, claim 14 recites “a basic body...which comprises a metal frame member that has at least *a partially closed profile cross-section defining a hollow space axially extending along the frame member*, said basic body comprising *at least two generally straight subsections which are connected via a third subsection of said frame member*, wherein said *third subsection comprises a generally C-shaped portion of said frame member that forms a widened area for at least partially encircling the HVAC unit.*” Pasch does not disclose or describe these features.

Claim 14 requires the frame member (which has a partially closed profile cross-section) to have a third subsection which, itself, has a generally C-shaped portion. In other words, there is a portion of the frame member that has a partially closed profile cross-section and a generally C-shape, and not merely a partially closed profile cross-section where that cross-section may be generally C-shaped. The PTO appears to interpret Pasch in two different ways in the rejection to the claims. In the Advisory Action dated June 21, 2007 (“the Advisory Action”), the PTO asserts that the middle part 3 is the generally C-shaped portion by itself. In the Final Office Action dated February 15, 2007 (“the Final Office Action”), the PTO asserts that the middle part 3 and the instrument panel 17 make up the generally C-shaped portion. Each approach is improper, as discussed below.

As to the assertion that the middle part 3 is the generally C-shaped portion, the PTO asserts that Figure 1 of Pasch makes “clear that cross member 1 has a partially closed cross section, because of at least openings 12 and sidewalls 11, and a C-shaped portion 3.” (Paragraph 4 of the Advisory Action.) However, the middle part 3 of Pasch has an L-shape cross section that is straight. The PTO’s interpretation that the L-shaped middle part is the generally C-shaped portion is not reasonable for the following two reasons.

First, the L-shape of Pasch is not generally C-shaped and certainly does not form a *widened area for at least partially encircling the HVAC unit*. The PTO asserts that Figures 1 and 2 make evident that “element 3 is wider than element 4, and is enclosed with three walls of element 3.” (Paragraph 6 of the Advisory Action.) It is respectfully submitted that Figures

1 and 2 show only two walls. Indeed, column 2, lines 37-39 of Pasch makes clear that the middle part 3 has two walls because it is described as “L-shaped,” and an L-shape simply does not have three walls. Figure 1 is a perspective view showing two walls of the middle part 3 but there is nothing to suggest a third wall either running under or behind the elements 4. Figure 2 merely shows a cross section view showing only the top wall of the middle part 3, and there is no indication of the existence of any other walls. Thus, Figures 1 and 2 do not disclose or suggest that the middle part 3 has three sidewalls.

Second, the L-shape of the middle part 3 is its cross section, and the generally C-shape is a separate requirement from the cross section. If the L-shape of the middle part 3 is interpreted as the generally C-shape, there is no structure left in the middle part 3 to satisfy the requirement that the generally C-shape portion has a partially closed profile cross section, which is separate and distinct from the L-shape. For example, the sidewalls 11 do not provide the partially closed profile cross section for the middle part 3, as asserted by the PTO in paragraph 4 of the Advisory Action, because the side walls 11 are not a part of the middle part 3 but are a part of the elements 4. Accordingly, the middle part 3 of Pasch does not have a partially closed profile cross section and a generally C-shape.

Thus, the middle part 3 of Pasch cannot be considered to be the third subsection because it does not have a partially closed profile cross section and a generally C-shape forming a widened area for at least partially encircling the HVAC unit.

As to the approach that the middle part 3 and the instrument panel 17 of Pasch form the generally C-shaped portion, the instrument panel 17 of Pasch, first of all, cannot be considered part of the frame member (which includes the generally C-shaped portion) because it is a separate element. Further, there is no teaching or suggestion that the instrument panel is made from metal. The PTO asserts that because the elements 3 and 4 are made of metal, the material of the element 17 is not excluded from being part of the frame member because the term “comprising” in claim 14 is inclusive and does not exclude additional, unrecited elements or method steps. (Paragraph 5 of the Advisory Action.) Use of “comprising” obviously does not excuse the PTO from the requirement of finding an “identical” description of the claimed elements in the prior art! Also, the frame member is defined as a metal frame member, which means that the entire frame member, as defined in the claim, is metal. The PTO’s interpretation effectively and improperly reads out the defined

structure of the frame member being made from metal. Thus, the instrument panel 17 is not part of the frame member and furthermore cannot be considered as such because there is no teaching that the panel 17 is made from metal.

Furthermore, even if the instrument panel 17 of Pasch were considered part of the third subsection (and the Applicant maintains that it cannot), the combination of the instrument panel 17 and the L-shaped middle part 3 still cannot be considered the third subsection of claim 14 because the combination of the instrument panel 17/middle part 3 does not have a generally C-shaped portion that forms a widened area for at least partially encircling the HVAC unit, which is a separate requirement from the partially closed profile cross-section. At best, the instrument panel 17 merely partially encloses the cross-bearer 1 (which may be related to the partially closed profile cross-section feature of claim 14), but there is no teaching or suggestion that the instrument panel 17/middle part 3 has a generally C-shape, apart from the partially closed profile cross-section.

Accordingly, under either approach, Pasch does not identically teach or suggest the third subsection of the basic body. Thus, claim 14 cannot be anticipated by Pasch.

Claims 15-18 and 21-28 depend from and contain all the subject matter of claim 14, and are allowable therewith for at least the same reasons as claim 14, without regard to the further features contained therein. For at least these reasons, reconsideration and withdrawal of the rejection are respectfully requested.

Obviousness Rejection of claims 19-20 based on Pasch and Mochizuki

As to the rejection of claims 19-20 under 35 U.S.C. 103(a), no combination of Pasch and Mochizuki teaches or suggests all the features of claims 19. For example, claim 19 depends from and contains all the features of claim 14. As discussed above, Pasch does not teach or suggest the third subsection of the basic body. Mochizuki does not cure this deficiency.

In addition, claim 19 (and claim 20 which depends from claim 19) requires that the “metal frame member of the basic body is at least partially formed from two metal ducts arranged parallel to each other.” The PTO asserts that Mochizuki teaches a duct 3 with ducts 4 and 5 provided above it, that is it a mere duplication of parts to add a second duct below the duct 3, and that it would have been obvious to include the ducts of Mochizuki placed on both

sides of the central "duct" of Pasch in order to improve formability and mount workability of an air conditioning duct. However, the proposed combination does not teach or suggest that the sides of the cross-bearer 1 of Pasch are ducts but, at best, merely adds additional ducts to the overall system of Pasch. In other words, merely adding ducts, as proposed by the PTO, does not satisfy the requirement of claim 19 because there is no teaching or suggestion that the side walls of the cross-bearer 1 are themselves ducts.

For at least these reasons, any combination of Pasch and Mochizuki does not teach or suggest all the features of claim 19 or 20, regardless of the appropriateness of the proposed combination (which need not be addressed here).

Conclusion

For the aforementioned reasons, claims 19-28 are respectfully submitted to be in condition for allowance. Withdrawal of the rejections is requested.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. § 1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date

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